

## REMARKS

### STATUS OF THE CLAIMS

Claims 9-20 are currently pending in the application. Of such claims, all were rejected in the current Office Action. While Applicants believe the unamended claims to be patentable, in order to further prosecution and to more clearly describe the currently claimed embodiment, Claim 9 is amended herein. Support for such change is replete throughout the specification as filed. *See, e.g.*, pages 6 and 9 which describe arrangement of members of a group and page 11 which describes organization of discussion, etc. Additionally, as per instructions in the Office Action, all non-elected claims are cancelled herein (*i.e.*, claims 1-8).

### REJECTIONS TO THE CLAIMS

#### 35 U.S.C. §101

Claims 9-20 were rejected in the Final Office Action under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Applicants respectfully traverse.

##### Concrete/Tangible

The Office Action states that the method steps of the invention are “abstract” in nature. The Office Action, quoting *State Street Bank*, holds that an invention must produce “a useful, concrete, tangible result.” *See, State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998). The Office Action then alleges that the current invention is neither “concrete” nor “tangible.”

As per the USPTO “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” (OG Notice 22 November 2005), hereinafter “Interim Guidelines,” an invention is patentable within 35 U.S.C. §101 if it “physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.” The four categories of enumerated subject matter within 35 U.S.C. §101 include: process, machine, manufacture, and composition of matter. Within the four enumerated categories are three judicial exceptions (*i.e.*, laws of nature, natural phenomena, and abstract ideas) that preclude inventions from patentability.

However, even inventions that might involve judicial exceptions (*e.g.*, laws of nature, etc.) are patentable under 35 U.S.C. §101 if they are an appropriate application of such

exceptions. Thus, laws of nature, natural phenomena, and abstract ideas are patentable subject matter if the claimed invention transforms an article or physical object to a different state or thing or if the claimed invention otherwise produces a useful concrete and tangible result.

According to the Interim Guidelines, *supra*, the focus should be “on the essential characteristics of the subject matter, in particular its practical utility.”

Under application of such standards, the currently claimed invention is patentable under 35 U.S.C. §101.

The current invention is a process (*i.e.*, a method of organizing discussion and members of a group) which falls within one of the four enumerated patentable groups of 35 U.S.C. §101. The invention also does not come within any of the judicial exceptions to 35 U.S.C. §101 (*i.e.*, laws of nature, natural phenomena, or abstract ideas). The invention clearly is not a law of nature (such as gravity, etc.), or a natural phenomena (such as a mineral, etc.), or an abstract idea (such as a mathematical formula, etc.). The invention is a method of organizing people and discussion in order to facilitate conflict resolution and, thus, within the patentable subject matter of 35 U.S.C. §101.

Even assuming, *arguendo*, that the particular result of the claims is viewed as an abstract idea (which, again, it is not since it is organization of, and discussion by, group members), the current claims are still patentable under the current guidelines because they produce a “useful, concrete, and tangible result.”

The invention is useful in that it is, *e.g.*, a clearly or specifically choreographed method for organizing members and discussion within a group. As per the Interim Guidelines cited above, for an invention to be useful it should satisfy the utility requirements of M.P.E.P. §2107, *et seq.* Thus, the usefulness or utility should be specific, substantial and credible. “Specific utility” is one that is specific to the subject matter claimed, as opposed to any utility that would be applicable to a broad class of the invention. The current specification recites the specific utility of the current invention throughout the application as filed. For example, pages 3-4 and 10 all give multiple examples of specific utility of the methods of the current invention. “Substantial utility” defines a “real world” use as opposed to one that requires or constitutes carrying out further research to identify or reasonably confirm the “real world” context. M.P.E.P. 2107.01(I). Again, the current invention, clearly states its substantial utility throughout the application as-filed. Again, for example, pages 3-4 and 10 give examples of such possible

real-world uses. An invention's utility is "credible" when it is even only partially successful in achieving a result. In order for an invention's utility to not be credible it must be totally incapable of achieving a useful result. M.P.E.P. §2107.01(II). Applicants respectfully point out that the claimed methods of organizing discussion and members of a group to facilitate conflict resolution has not been shown by the Office Action to be completely and utterly inoperative, nor has the Office Action offered an explanation that clearly sets forth reasoning for any purported incredulity (*e.g.*, any factual findings relied upon or an evaluation of all relevant evidence), and thus, the Office Action has not presented a *prima facie* case.

M.P.E.P. §2107.01(I) emphasizes that examination "should focus on and be receptive to assertions made by the applicant that an invention is 'useful' for a particular purpose." M.P.E.P. §2107(I) also states that if an applicant has "asserted that the claimed invention is useful for any particular practical purpose (*i.e.*, it has a "specific and substantial utility") and the assertion would be considered credible by a person of ordinary skill in the art," then a rejection based on lack of utility should not be imposed.

The invention is concrete in that the steps involved are clearly presented. The Office Action states that the result is not concrete because "it cannot be reasonably assured that conflict resolution will be predictably enabled by the steps set forth" and that it is too subjective since conflict resolution relies on the state of mind of the participants. However, Applicants respectfully point out that the current claims are drawn to methods of organizing discussion and members in a group to facilitate conflict resolution. Thus, the claims are not to conflict resolution in the absolute, but rather to specific concrete actions to facilitate such resolution. Therefore, the process is substantially repeatable and not irreproducible. *See* Interim Guidelines, *supra*, quoting *In re Swartz* 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000).

The invention provides a tangible result in that the members of the group are choreographed for discussion. Applicants respectfully disagree with the Office Action's characterization of the invention as "merely manipulat[ing] abstract ideas without producing physical transformation or conversion of the subject matter." Again, Applicants point out that under the USPTO Interim Guidelines, it is not a requirement that all inventions must produce a change of character or condition in some physical object as per *In re Warmerdam*, 31 USPQ2d 1754 (Fed. Cir. 1994). However, even if such requirement were relevant, the current invention still meets this requirement because the members of the group are choreographed to speak, move,

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Page 8

etc. (*i.e.*, thus producing a change of character/condition of a physical object). The current invention sets forth a practical application to produce a real-world result, *e.g.*, it organizes members of a group and discussion within a group to facilitate conflict resolution.

“Technological Arts”

The Office Action alleges that the current invention also does not fall within the “useful or technological arts.” Office Action at page 4. Applicants respectfully traverse.

The Board of Patent Appeals and Interferences has clearly ruled that “there is currently no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under §101.” *See, Ex parte Carl A. Lundgren*, Appeal No. 2003-2088 and Interim Guidelines, *supra*. It is improper to ask whether the current invention is within the “technological arts” since such question is moot in terms of patentability under 35 U.S.C. §101.

In sum, the current invention does fall within the area of patentable subject matter under 35 U.S.C. §101 since the claims are drawn to a process not involving a law of nature, a natural phenomena, or an abstract idea. Additionally, even assuming, *arguendo*, that the claims involve an abstract idea, they are still patentable subject matter since they provide a useful, concrete, tangible result, *e.g.*, organization of members and discussion in a group in order to facilitate conflict resolution. Therefore, Applicants respectfully request that the rejections be withdrawn.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. In the event that substantive matters are felt to remain, the Examiner is invited to telephone Carol A. Trufant at (510) 653-1294.

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